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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/569,496

02/27/2006

Shlomo Magdassi

MAGDASSI 1A

3455

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EXAMINER

WIESE, NOAH S

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

06/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/569,496</p>	<p>Applicant(s) MAGDASSI ET AL.</p>	
	<p>Examiner NOAH S. WIESE</p>	<p>Art Unit 1793</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-35.
Claim(s) withdrawn from consideration: 36-43.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Karl E Group/
Primary Examiner, Art Unit 1793

Applicant has objected to the withdraw of the newly added claims 36-43. Applicant contends that withdrawing these claims was improper because the original disclosure teaches a method as well as an ink composition. However, the originally disclosed claims were drawn to an ink composition only. Applicant elected this embodiment of the invention for examination on merits by the presentation of the original claims. Therefore, restriction of the subsequently presented claims from the originally presented claims is proper if the new claims are drawn to a patentably distinct invention. In the instant case the subsequently presented claims (36-43) are drawn to a distinct invention. The invention is distinct because the process of claims 36-43 could be carried out using a different and materially different ink than that presented in claims 1-35. Specifically, the process could be carried out with a ink having a wax vehicle and/or an ink that becomes part of substrate only after exposure to temperatures above 700C. Thus, the subsequently added claims are to an invention that is patentably distinct, so restriction of the claims from those already examined in the previous office action was proper in this case.

Applicant further argues that because the application was filed under U.S.C. 371 as a national stage of a PCT application, the newly added claims cannot be restricted because there is unity of invention. However, unity of invention is lacking because, as shown in the previous office action, the ink composition that is the technical feature that the claims share is not a special technical feature because it is obvious over Nyssen in view of Nicolin. Therefore, since the claims do not share subject matter that can be considered a special technical feature, the two distinct inventions are lacking in unity and can be properly restricted. Further, a search burden would exist if both inventions were to be searched because printing methods contain limitations not found in ink compositions, such as methods of applying heat energy. Thus, there is both reason for restricting the claims and reason why there would be a search burden, and the restriction requirement previously issued is maintained.

Because, as discussed above, the restriction requirement of the subsequently added claims from those originally presented is maintained, applicant's arguments that the previous office action was incomplete and that finality should be withdrawn are not persuasive. Finality is not withdrawn.

Applicant's arguments regarding the previously issued rejections over the prior art are based on the proposed amended claims. The amendments to the claims will not be entered because they raise new issues that would require a new search and consideration. Specifically, the proposed amendments would raise the issue of solids content in the ink for the first time during prosecution, and this would clearly necessitate searching the prior art for its teaching on solids content in glass substrate printing. Because the amendments are not entered, applicant's arguments drawn to the amended claims are moot, and do not place the application in condition for allowance.